

47. (Amended) A method as claimed in claim 45 further comprising displaying an image on said removable cap related to the book theme.

REMARKS

Summary of Office Action

Claims 1-35, 37-61, and 63-68 are pending in the application. Claims 1-35, 37, 38, 40-61 and 63-68 have been finally rejected under 35 U.S.C. 103(a) as being obvious from "ISBN 0-439-20822" (hereafter "ISBN"). Claim 39 was finally rejected under 35 U.S.C. 103(a) as being obvious from ISBN in view of Phelps U.S. Patent No. 3,217,866 (hereafter "Phelps").

Summary of Applicants' Reply

Claims 7, 34, 38, 59, and 64 have been cancelled without prejudice. The subject matter in these claims has been incorporated into independent claims 1 and 44, upon which they depend.

Claim 9 has been cancelled without prejudice.

Claim 47 has been amended in response to the amendment of claim 44, upon which it depends. Additionally, claim 47 has been amended to more particularly point out and distinctly claim the subject matter which applicants regard as their invention.

Applicants Reply

to the Final Rejections under 35 U.S.C. § 103(a)

Applicants' invention is that of a book having a theme and capable of displaying coins. Coins are displayed in applicants' invention by means of coin receivable apertures defined in at least one of the book's covers. Additionally, applicants' invention is tailored to display

those coins with the same theme as that of the book's covers, pages, and coin receivable apertures.

Applicants' invention is unique because at least one of the coin receivable apertures is defined on the exterior of at least one of the book's covers. As a result, coins may be displayed and manipulated even after the book is closed. Furthermore, applicants' invention provides utility even when coins are not placed in the apertures by incorporating theme-related pre-printed information on the book's pages. This information may be, for example, a story about an image depicted on a specific coin. In preferred embodiments of applicants' invention, only a small number of coin receivable apertures are included.

It should be noted that coin displays and coin holding folders are well known in the art and may be used to store a large number of coins for collecting purposes. These prior art folders protect coins when closed and display them when open.

ISBN is a prior art folder that may store the entire collection of fifty state quarters. These quarters may be stored in coin receivable apertures that are defined in plastic sheets attached to the interior of the folder. These plastic sheets are transparent and placed on the interior of the folder in such a manner that the apertures align with coin names illustrated on the interior. As a result, the coin names appear to be located in the coin receivable apertures. Additionally, a pamphlet is discussed by ISBN, but it is not directly attached to the folder.

Phelps is a prior art coin collecting book that may be used to store unrelated coins. Phelps discusses pages attached to and between the book's covers in which coin receivable apertures are defined.

The Examiner argued, in regards to claims 34 and 59, that "it would have been obvious to one having ordinary

skill in the art at the time the invention was made to place the aperture at any desirable location on the cover, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse* 86 USPQ 70" (Examiners' Action, page 4).

As noted above, applicants have cancelled claims 34 and 59. As also noted, the subject matter of these claims has been included in amended independent claims 1 and 44. For this reason, applicants assume that the Examiner's rejection of claims 24 and 59 now also applies to claims 1 and 44. Applicants' arguments below traverse these outstanding rejections.

In regards to newly amended claims 1 and 44, applicants' invention teaches a coin displaying book with at least one or more coin receivable apertures located on the exterior of at least one of its covers (Applicants' Spec., FIGS. 1 and 4). As a result, coins may be displayed, removed, and placed in these exterior apertures even after the book is closed.

ISBN does not discuss defining apertures in at least one of the covers, as suggested by the Examiner. Instead, ISBN teaches a transparent piece of plastic that is attached to the cover's interior and in which coin receivable apertures are defined.

None of the prior art discusses a folder, let alone a book, in which coin receivable apertures are defined in the exterior of at least one of the covers. These prior art folders only define the coin receivable apertures on the interior of the covers or pages located between them. Therefore, when these prior art displays are closed, the apertures may not be displayed and coins may not subsequently be removed, placed, or displayed in them. For these reasons, the prior art pertains more specifically to a

way of storing and collecting coins, not displaying them as taught by applicants' invention.

Furthermore, while *In re Japikse* 86 USPQ 70 states there is no invention in shifting a component to a different position only if "the operation of the device would not thereby be modified" (*In re Japikse* 86 USPQ 73), nevertheless, applicants have shown above that the operation of a folder or book would be modified if the coin receivable apertures were moved from the interior of a cover to the exterior of one. For at least the above reasons, claims 1 and 44 are allowable because the prior art does not show or suggest placing the coin receivable apertures in the exterior of at least one of the covers. Since claims 1 and 44 are allowable, claims 2-43 and 45-68 are also allowable since they depend on claims 1 and 44.

To aid the Examiner in visualizing what applicants regard as their invention, Exhibit A has been attached to the end of this Reply. Exhibit A is a photocopy of one embodiment of applicants' invention. Specifically, Exhibit A is a Sacagawea dollar coin displaying book with the theme of a Sacagawea dollar coin. Some elements of Exhibit A are described below:

Page 1 of Exhibit A illustrates the first book cover in which two coin receivable apertures are defined. The book theme is present inside each coin receivable aperture in the form of a life-size image of one side of a Sacagawea dollar. Also, the book theme is present on the front cover in the form of a Sacagawea portrait.

Pages 2 to 29 of Exhibit A show the importance of the pre-printed information contained on the pages of the book. These pages are also associated with the book's theme. Pages 6-25 contain pre-printed information telling the story of Sacagawea. Pages 26 and 27 contain pre-printed

information describing the history of the Sacagawea coin as well as details pertaining to the coin's production.

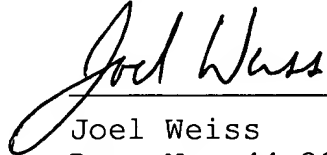
The final rejections of claims under 35 U.S.C. § 103(a) are traversed.

Conclusion

Applicants have demonstrated the claimed subject matter is in condition for allowance.

An early and favorable action is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, reading "Joel Weiss", is written over a horizontal line.

Joel Weiss
Reg. No. 44,398
Attorney for Applicants
FISH & NEAVE
Customer Number 1473
1251 Avenue of the Americas
New York, New York 10020-1104
Tel.: (212) 596-9000

APPENDIX

In The Claims

1. (Twice Amended) A book having a theme and capable of displaying one or more coins related to [its] the theme, comprising:

a first book cover;

a second book cover joined to said first book cover, wherein the exterior of at least one of said first and second book covers defines one or more coin receivable apertures, wherein an image related to the book theme is displayed in at least one or more of said one or more coin receivable apertures, and wherein the book theme is displayed on at least one of said first and second book covers; and

a plurality of sheets fastened together and attached to at least one of said first and second book covers, and wherein at least one of said plurality of sheets provides pre-printed information related to the book theme.

44. (Twice Amended) A method of [generating] making a book having a theme and capable of displaying one or more coins related to [its] the theme comprising:

providing a first book cover;

joining a second book cover to said first book cover, wherein the exterior of at least one of said first and second book covers defines one or more coin receivable apertures, wherein an image related to the book theme is displayed in at least one or more of said one or more coin receivable apertures, and wherein at least one of said first and second book covers displays the book theme; and

attaching a plurality of sheets fastened together to at least one of said first and second book covers, wherein at least one of said plurality of sheets provides pre-printed information related to the book theme.

47. (Amended) A method as claimed in claim 45 further comprising displaying an image on said removable cap related to the book theme.